

Appln. No. 10/760,322
Filed: January 16, 2004
Amendment submitted April 28, 2008
Reply to Office action mailed November 28, 2007

REMARKS

Claims 22-73 are pending in the Application and all have been rejected in the Office action mailed November 28, 2007. Claims 22, 41, 42, 45, 54, 70, 71, and 72 have been amended, claims 40 and 69 have been cancelled without prejudice or disclaimer, and new claims 74-76 have been added. Claims 22, 45, and 54 are independent claims, from which claims 23-44 and 74, claims 46-53 and 75, and claims 55-73 and 76 depend, respectively. Applicants respectfully request reconsideration of claims 22-73, and consideration of new claims 74-76, in light of the following remarks.

Amendments to the Claims

Applicants have amended claims 22, 41, 42, 45, 54, 70, 71, and 72 as shown above. Applicants respectfully submit that these amendments do not add new matter.

Rejections of Claims

Claims 22-24, 26, 30, 45, 49, 54-56, and 59 were rejected under 35 U.S.C. §102(e) as being anticipated by Bertland (US 5,596,573). Claims 25, 31, 32, 36, 47, 48, 50, 60, 61, and 65 were rejected under 35 U.S.C. §103(a) as be unpatentable over Bertland in view of Dinkins (US 5,678,172). Claims 27-29, 34, 35, 57, 58, 63, and 64 were rejected under 35 U.S.C. §103(a) as be unpatentable over Bertland in view of Averbuch (US 5,268,933). Claims 33, 46, and 62 were rejected under 35 U.S.C. §103(a) as be unpatentable over Bertland in view of Smith et al. (US 5,796,772, hereinafter "Smith"). Claims 37-39, 51-53, and 66-68 were rejected under 35 U.S.C. §103(a) as be unpatentable over Bertland in view of Stein (US 5,628,055). Claims 40-44 and 69-73 were rejected under 35 U.S.C. §103(a) as be unpatentable over Bertland in view of Kudo et al. (US 5,148,429, hereinafter "Kudo"). Applicants respectfully traverse the rejections. Applicants have amended claims 22, 41, 42, 45, 54, 70, 71, and 72 as shown above, to clarify the subject matter of the claims. Applicants respectfully submit that these amendments render the rejections of the instant Office action moot.

I. Bertland Does Not Anticipate Claims 22-24, 26, 30, 45, 49, 54-56, and 59

With regard to the anticipation rejections, MPEP 2131 states, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP 2131 also states, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants first address the alleged teachings of Bertland with respect to Applicants’ claims 22, 45, and 54, which Applicants have amended to recite, in part, “...wherein the phone supports concurrent, bidirectional voice communication; and wherein the at least one processor monitors the first voice stream for a lack of speech for a minimum period of time...”, as recited by Applicants’ amended claim 22; “...wherein the phone circuit supports concurrent, bidirectional voice communication; and wherein the at least one processor monitors the first digital representation of sound for a lack of speech for a minimum period of time...”, as recited by Applicants’ amended claim 45; and “...wherein the phone supports concurrent, bidirectional voice communication; and wherein processing the outgoing digital voice data comprises monitoring the outgoing digital voice data for a lack of speech for a minimum period of time...”, as recited by Applicants’ amended claim 54. Applicants respectfully submit that Bertland does not teach or suggest all of the features of Applicants’ claims 22, 45, and 54.

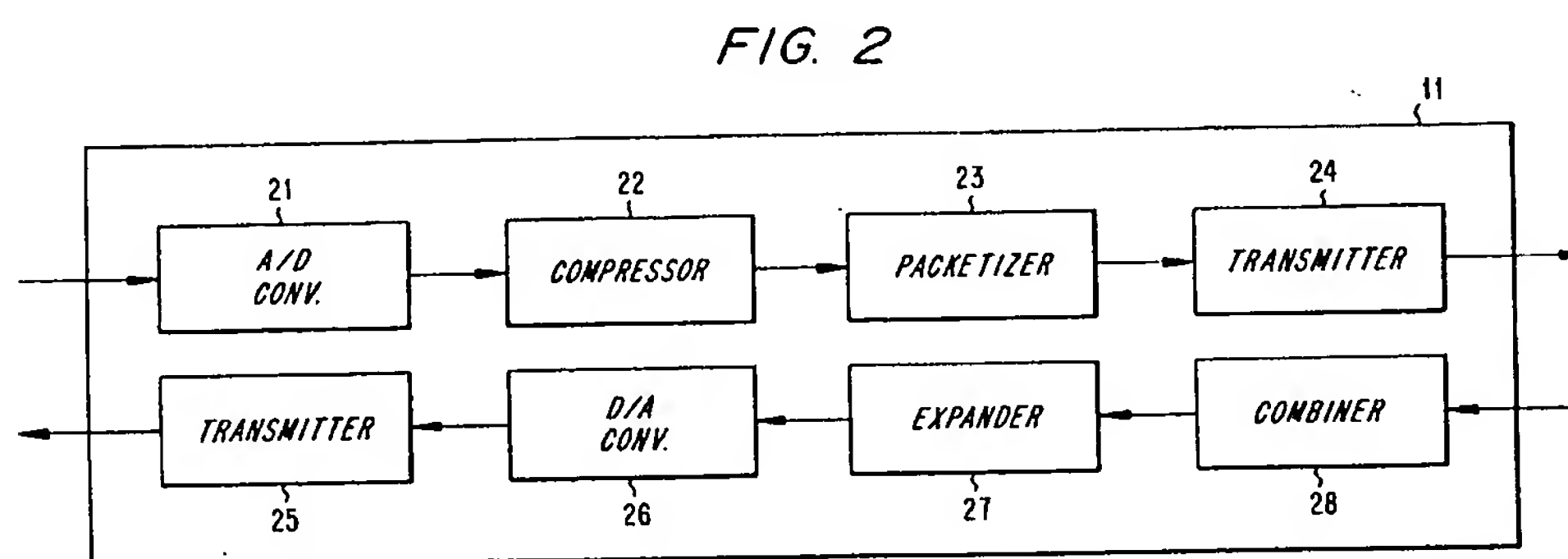
Applicants respectfully submit that the Office has misinterpreted the language of claims 22, 45, and 54, which are drawn to “[a] phone supporting voice communication via a wireless packet network...”, “[a] phone circuit supporting voice communication via a wireless packet network...”, and “[a] method of operating a phone supporting voice communication via a wireless packet network...”, respectively. Applicants respectfully submit that the term “phone” is a well known term in common usage that would be instantly and unquestioningly recognized by one of ordinary skill in the relevant art as a device that permits concurrent, bidirectional voice communication. Applicants respectfully submit that the Bertland reference relates to “...a method for transferring

voice **messages**.” See column 1, lines 5-6. Bertland clearly discloses that the invention makes it possible to transfer voice **messages** to a “mobile terminal” via a “packet-switched narrow-band radio data network” that can be “...a paging system, MOBITE[®]X or another network of equivalent type.” See column 3, line 1 to column 4, line 20. Applicants respectfully submit that Bertland does not teach or suggest that the “mobile terminal” is a “phone”, or that the “packet-switched narrow band radio data network” is a network that would be compatible with a “phone”. Therefore, Applicants respectfully submit that while Bertland may disclose a “packet-switched narrow band radio data network” such as a “paging system” that delivers “voice messages” to “mobile terminals”, Bertland does not, however, teach a “phone” in accordance with Applicants’ claims 22, 45, and 54.

In order to avoid further misinterpretation, Applicants have amended claims 22, 45, and 54 to add language to clarify what Applicants respectfully submit is well known to those of ordinary skill in the relevant art regarding the nature of a “phone”. Applicants respectfully submit that the Bertland reference does not teach or suggest, at least, “...wherein the phone supports concurrent, bidirectional voice communication;...”, as recited by Applicants’ amended claims 22 and 54; and “...wherein the phone circuit supports concurrent, bidirectional voice communication;...”, as recited by Applicants’ amended claim 45. Instead, Bertland teaches the transfer of **voice messages**, to “mobile terminals” in a “packet-switched narrow band radio data network”. While Bertland may teach that “...[v]oice messages may be bi-directionally transferred between the public telephone network and the terminals by a gateway arranged to connect the public telephone network and the packet-switched narrow band radio data network...” (at Abstract), Bertland fails to teach or suggest that “voice messages” may be transferred to and from one of the “terminals” **concurrently**.

In addition, Applicants respectfully submit that Bertland does not teach or suggest, at least, “...wherein the at least one processor monitors the first voice stream for a lack of speech for a minimum period of time...”, as recited by Applicants’ amended claim 22; “...wherein the at least one processor monitors the first digital representation of sound for a lack of speech for a minimum period of time...”, as recited by Applicants’ amended claim 45; and “...wherein processing the outgoing digital voice data comprises

monitoring the outgoing digital voice data for a lack of speech for a minimum period of time...”, as recited by Applicants’ amended claim 54. Applicants respectfully submit that the Office relies upon Fig. 2 and column 4, lines 37-48 of Bertland for support of its rejection of Applicants’ claims 22, 45, and 54. Applicant will first address the teachings of Fig. 2, shown below:



Although Fig. 2 of Bertland shows a variety of elements, Bertland clearly discloses that Fig. 2 is “...an exemplary block diagram of a **gateway** according to the invention....” See column 2, lines 66-67. Applicants respectfully submit that a **gateway** is different from and does not anticipate a “phone”, as recited by Applicants’ claims 22, 45, and 54. In addition, Applicants respectfully submit that nothing in Fig. 2 of Bertland teaches or suggests “...wherein the at least one processor monitors the first voice stream for a lack of speech for a minimum period of time...”, as recited by Applicants’ amended claim 22; “...wherein the at least one processor monitors the first digital representation of sound for a lack of speech for a minimum period of time...”, as recited by Applicants’ amended claim 45; and “...wherein processing the outgoing digital voice data comprises monitoring the outgoing digital voice data for a lack of speech for a minimum period of time...”, as recited by Applicants’ amended claim 54. Bertland fails to make any mention of “monitoring” for “...a lack of speech for a minimum period of time...”, as recited by Applicants’ amended claims 22, 45, and 54. Therefore,

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Applicants respectfully submit that Fig. 2 of Bertland does not teach or suggest at least this aspect of Applicants' amended claims 22, 45, and 54.

Applicants now turn to Bertland at column 4, lines 37-48, which state:

In the above-described device the invention has been used for transfer of voice messages from a telephone in a public telephone network to a mobile terminal in a packet-switched narrow band radio data network. Many of the packet-switched radio networks are however meant for traffic in both directions. The invention is used in such networks for two-way communication by means of supplementing the terminals with a microphone and means for analog-digital conversion and for compression. In a corresponding manner, the gateway has also to be provided with means for expansion 27, combining 28, and digital-analog conversion 26 and transmitter 28.

Applicants respectfully submit that the cited portion of Bertland simply teaches that the method of Bertland may be used bi-directionally, to transmit voice messages to/from the "mobile terminal". This portion of Bertland, however, fails to teach or suggest anything with respect to "...wherein the at least one processor monitors the first voice stream for a lack of speech for a minimum period of time...", as recited by Applicants' amended claim 22; "...wherein the at least one processor monitors the first digital representation of sound for a lack of speech for a minimum period of time...", as recited by Applicants' amended claim 45; and "...wherein processing the outgoing digital voice data comprises monitoring the outgoing digital voice data for a lack of speech for a minimum period of time...", as recited by Applicants' amended claim 54. Indeed, neither Fig. 2, nor the cited portion of Bertland at column 4, lines 37-48, nor any other portion or figure of Bertland teaches or suggests at least these aspects of Applicants' amended claims 22, 45, and 54.

Based at least upon the above, Applicants respectfully submit that the Bertland reference does not teach each and every element of Applicants' amended claims 22, 45, and 54, as required by M.P.E.P. §2131, that Bertland does not anticipate Applicants' amended claims 22, 45, and 54, and that a rejection of claims 22, 45, and 54 under 35 U.S.C. §102(e) cannot be maintained.

With regard to claims 23, 49, and 55, the Office asserts that Bertland teaches "...[a]t least one interface for accepting input from a user (address input 3, Bertland Fig. 1); and [t]he at least one interface for providing feedback to a user (speaker 10, Bertland Fig. 1)." See Office action at page 3. Applicants respectfully submit that "address input 3" of Bertland is part of the "Telephone 1", and that "speaker 10" is connected to the "mobile terminal 9" of Bertland.

Applicants respectfully submit that in rejecting a claim under 35 U.S.C. §102(e), it is not sufficient to simply identify in a reference the teachings that allegedly correspond to the elements of Applicants' claims, but that as MPEP 2131 clearly states, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." While it is not required that the words used in the claim be the exact words used in the reference, the structure or relationship of the elements defined in the claim must, however, also be present in the reference. Applicants respectfully submit that an "address input 3" on one element in the "communication network" of Fig. 1 of Bertland, and a "speaker 10" connected to a different element of the "communication network" of Fig. 1, do not teach the same structure of a "phone"/"phone circuit" as recited in Applicants' claims 22 and 45, or teach or suggest the method of operation of a "phone" recited in Applicants' claim 54. Therefore, for at least these reasons, Applicants respectfully submit that Bertland also does not anticipate claims 23, 49, and 55.

With regard to claims 26 and 56, Applicants respectfully submit that, again, the Office cites teachings ("microphone 2" of "telephone 1", and "speaker 10" connected to "mobile terminal 10" of Fig. 1 of Bertland) that do not reflect the structure recited in the language of claims 22 and 54, from which claims 26 and 56, respectively, depend. Therefore, Applicants respectfully submit that Bertland does not anticipate the features of Applicants' claims 26 and 56.

Therefore, Applicants believe that claims 22, 23, 26, 45, 49, 54, 55, and 56 are allowable, for at least the additional reasons set forth above. Applicants respectfully submit that claims 23-44, 46-53, and 55-73 depend, either directly or indirectly, from claims 22, 45, and 54, respectively. Because claims 23-44, 46-53, and 55-73 depend

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from allowable claims 22, 45, and 54, Applicants respectfully submit that claims 22-44, 46-53, and 55-73 are allowable over Bertland, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 22-24, 26, 30, 45, 49, 54-56, and 59 under 35 U.S.C. §102(e) be reconsidered and withdrawn.

II. The Proposed Combination Of Bertland And Dinkins Does Not Render Claims 25, 31, 32, 36, 47, 48, 50, 60, 61, And 65 Unpatentable

Applicant respectfully submits that the Office action has failed to establish a *prima facie* case of obviousness, in accordance with M.P.E.P. §2142. According to M.P.E.P. §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. §2142 further states that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." As recognized in M.P.E.P. §2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In addition, the Federal Circuit has made clear that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396.

Applicants respectfully submit that claims 25, 21, 32, and 36, claims 47, 48, and 50, and claims 60, 61, and 65 depend, respectively, from claims 22, 45, and 54. Applicants believe that claims 22, 45, and 54 are allowable over the proposed combination of references, in that the Office has failed to set forth a reasoned explanation of how and why Dinkins overcomes the shortcomings of Bertland, set forth above, as required by M.P.E.P. §2142. Because claims 22, 45, and 54 are allowable over the proposed combination of references, Applicants respectfully submit that claims 25, 31, 32, 36, 47, 48, 50, 60, 61, and 65 are also allowable, for at least the same reasons. Therefore, Applicants respectfully request that the rejection of claims 25, 31,

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32, 36, 47, 48, 50, 60, 61, and 65 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

III. The Proposed Combination Of Bertland And Averbuch Does Not Render Claims 27-29, 34, 35, 57, 58, 63, And 64 Unpatentable

Applicants respectfully submit that claims 27-29, 34, and 35, and claims 57, 58, 63, and 64 depend from claims 22 and 54, respectively. Applicants believe that claims 22 and 54 are allowable over the proposed combination of references, in that the Office has failed to set forth a reasoned explanation of how and why Averbuch overcomes the shortcomings of Bertland, set forth above, as required by M.P.E.P. §2142. Because claims 22 and 54 are allowable over the proposed combination of references, Applicants respectfully submit that claims 27-29, 34, 35, 57, 58, 63, and 64 are also allowable, for at least the same reasons. Therefore, Applicants respectfully request that the rejection of claims 27-29, 34, 35, 57, 58, 63, and 64 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

IV. The Proposed Combination Of Bertland And Smith Does Not Render Claims 33, 46, And 62 Unpatentable

Applicants respectfully submit that claims 33, 46, and 62 depend from claims 22, 45, and 54, respectively. Applicants believe that claims 22, 45, and 54 are allowable over the proposed combination of references, in that the Office has failed to set forth a reasoned explanation of how and why Smith overcomes the shortcomings of Bertland, set forth above, as required by M.P.E.P. §2142. Because claims 22, 45, and 54 are allowable over the proposed combination of references, Applicants respectfully submit that claims 33, 46, and 62 are also allowable, for at least the same reasons. Therefore, Applicants respectfully request that the rejection of claims 33, 46, and 62 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

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V. The Proposed Combination Of Bertland And Stein Does Not Render Claims 37-39, 51-53, And 66-68 Unpatentable

Applicants respectfully submit that claims 37-39, 51-53, and 66-68 depend from claims 22, 45, and 54, respectively. Applicants believe that claims 22, 45, and 54 are allowable over the proposed combination of references, in that the Office has failed to set forth a reasoned explanation of how and why Stein overcomes the shortcomings of Bertland, set forth above, as required by M.P.E.P. §2142. Because claims 22, 45, and 54 are allowable over the proposed combination of references, Applicants respectfully submit that claims 37-39, 51-53, and 66-68 are also allowable, for at least the same reasons. Therefore, Applicants respectfully request that the rejection of claims 37-39, 51-53, and 66-68 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

VI. The Proposed Combination Of Bertland And Kudo Does Not Render Claims 40-44 And 69-73 Unpatentable

Applicants respectfully submit that claims 40-44 and 69-73 depend from claims 22 and 54, respectively. Applicants believe that claims 22 and 54 are allowable over the proposed combination of references, in that the Office has failed to set forth a reasoned explanation of how and why Kudo overcomes the shortcomings of Bertland, set forth above, as required by M.P.E.P. §2142. Because claims 22 and 54 are allowable over the proposed combination of references, Applicants respectfully submit that claims 40-44 and 69-73 are also allowable, for at least the same reasons. Therefore, Applicants respectfully request that the rejection of claims 40-44 and 69-73 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Newly Added Claims

Applicants have added new dependent claims 74, 75, and 76 that depend from claims 22, 45, and 54, respectively. Support for new claims 74-76 may be found, for example, at pages 39, 40, and 217-219, and Figs. 46b and 55b of the Application. Applicants respectfully submit that new claims 74-76 do not add new matter.

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Conclusion

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim). An early Office Action on the merits and allowance of claims 22-76 is respectfully requested.

Applicants respectfully submit that the claims of the present application should be in condition for allowance for at least the reasons discussed above. Applicants respectfully request that the finality of the Office action be withdrawn, and that the outstanding rejections be reconsidered. If the Examiner has any questions or Applicants can be of any assistance, the Examiner is invited to contact the undersigned.

The Commissioner is hereby authorized to charge the fees under 37 C.F.R. §1.17(a)(2) for the Petition Under 37 C.F.R. §1.136(a), and any other fees required by this submission, or to credit any overpayment, to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Dated: April 28, 2008

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